

REMARKS

The present amendment is being filed with a Request for Continued Examination and addresses the arguments made in the final Office Action mailed on July 17, 2006.

Upon entry of the present amendment, claims 11, 169-175, 178, 179, 181-208, and 220-231 will be pending and under examination. Claim 177 has been cancelled. Claims 11, 170, 174, and 191 have been amended. New claims 220-231 have been added. Claims 11 and 170 has been amended to remove the phrase an "N-terminal fragment thereof." Claim 174 adopts much of the language of claim 11 for a method using "an N-terminal fragment of an H3 or an H4 histone protein." Support for "an N-terminal fragment of an H3 or an H4 histone protein" in amended claims 174 and 191 and new claims 220-231 can be found in the specification as filed, e.g., in Figures 5A, 5B, and 5C, their descriptions on pages 10-11, and on pages 76-77. Applicants submit that no new matter has been added.

Interview Summary

The Applicants' undersigned representative thanks the Examiner for a courteous telephonic interview conducted on June 28, 2007. Potential claim amendments were discussed in view of the pending rejections.

Rejections for Double Patenting

The Examiner rejected claims 1, 171, 173, 179, 181-185, 191-194 and 207-208 on the ground of nonstatutory obviousness-type double patenting (Office Action at page 3). According to the Examiner, the claims allegedly are "unpatentable over claims 118-130 of copending Application No. 09/735,786" (at page 3). The Examiner further stated at page 4 that: "[t]his is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented" (emphasis in the original).

Applicants do not accede to the substance of this rejection. As noted by the Examiner this is a provisional rejection over the co-pending application 09/735,786. Accordingly, Applicants request that the Examiner follow the procedures elaborated in MPEP § 804.I.B (and

B1.), which authorizes advancing one application to issuance where a provisional double patent rejection is made between two pending applications. These sections state in particular:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications.

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. (emphases added)

Based on the present amendment, Applicants expect that this provisional double patenting rejection will be "the only rejection remaining" in this application. The Examiner of 09/735,786 will be notified of the double patent rejection made in this application. It is noted that the 09/735,786 case has yet to be examined, despite Applicants' inquiries. Further, this application has an earlier filing date than 09/735,786. Accordingly, the double patent rejection made in this application should be withdrawn so that, of the two, the present application may be the first to issue as a patent.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 11, 169-175, 177-179, and 181-208 as allegedly failing to comply with the written description requirement, stating:

Applicant has amended claims 11, 170 and 191 to recite "or an N-terminal fragment thereof. . ." This phrase does not appear in the specification, or original claims as filed. Applicant does not point out specific basis for this limitation in the application, and none is apparent. Therefore this limitation is new matter (Office Action at page 4).

Without conceding the argument, but solely in the interest of moving the application toward allowance, Applicants amended claims 11 and 170 to remove the phrase an "N-terminal fragment thereof," rendering the rejection of these claims moot. Claims 169, 171-173, 175, 178, 179, and 181-190 depend from claim 11, and their rejections are likewise obviated by this amendment. Claim 177 has been cancelled.

Applicants amended claims 174 and 191 to recite an N-terminal fragment of an H3 or an H4 histone protein. Support for amended claims 174 and 191 can be found in the specification as filed, e.g., in Figures 5A, 5B, and 5C and their descriptions on pages 10-11, and on pages 76-77. For example, Figure 5A “depicts the amino acid sequences of the N-terminal tails of H3 . . . and H4 . . . peptides,” Figure 5B “depicts the effects of mSir2 α and ySir2p on diacetylated H3 peptide (diAc), but not unacetylated H3 (unAc),” and Figure 5C “illustrates mSir2 α modification of Lys16-acetylated H4 peptide” (at pages 10-11, SEQ ID NOs omitted). Pages 76-77 of the specification further describe these experiments. Claims 192-208 depend from either claim 11 or 191.

New claims 220-227 depend from either claim 174 or 191 and recite fragments of the H3 or the H4 histone proteins with specific sequence identifiers. The recited sequences can be found, e.g., in Figure 5A and its description at page 10 of the specification. Support for reciting sequences of amino acids 1-20 of SEQ ID NO:6 in claims 221, 224, 227, and 230 can be found in the specification at page 76, lines 10-11.

Given the discussed support for amended claims in the specification, a skilled practitioner would understand that Applicants were in possession of the claimed embodiments. Therefore, reconsideration and withdrawal of the written description rejections is respectfully requested.

Conclusion

Applicants respectfully submit that all claims are in condition for allowance, which action is expeditiously requested. Applicants do not concede any positions of the Examiner that are not expressly addressed above, nor do Applicants concede that there are not other good reasons for patentability of the presented claims or other claims. All amendments and withdrawals are made without prejudice and disclaimer.

Applicant : Leonard Guarente *et al.*
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Enclosed is a Petition for Five-Month Extension of Time. Please apply the required fee and any other charges or credits to deposit account 06-1050, referencing Attorney's Docket Number 13407-016001.

Respectfully submitted,

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Anna Solowiej
Anna Solowiej, Ph.D.
Reg. No. 57,093

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906